

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 76/212,456
Filed: February 20, 2001
For Trademark: BAMA and Design
Published in the Official Gazette on December 16, 2003

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ATHLETICS INVESTMENT GROUP LLC, D/B/A THE
OAKLAND ATHLETICS BASEBALL COMPANY

Opposer,

v.

THE BOARD OF TRUSTEES OF THE UNIVERSITY OF
ALABAMA,

Applicant.
-----X

Opposition No.

NOTICE OF OPPOSITION



06-14-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Commissioner of Trademarks
BOX TTAB FEE
2900 Crystal Drive
Arlington, VA 22202-3514

Opposer, Athletics Investment Group LLC, d/b/a The Oakland Athletics Baseball Company, a California limited liability company, having its principal place of business at 7000 Coliseum Way, Second Floor, Oakland, California 94621 ("Opposer"), believes that it will be damaged by registration of the BAMA and Elephant Design mark for a variety of goods in International Classes 6, 11, 14, 16, 20, 21, 25, and 28, as shown in Application Serial No. 76/212,456 ("the Application"), and having been granted extensions of time to oppose up to and including June 13, 2004, hereby opposes same.

As grounds for opposition, it is alleged that:

1. Opposer is the owner of the OAKLAND ATHLETICS Major League Baseball club ("Club"), which is well-known by sports fans and enthusiasts, the press and the general public.

06/16/2004 JBR/DK/SL 00000106 031952 76212456

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Opposition to Serial No. 78/068,670
Docket No. 52933-24003.33

2. Since long prior to the Application filing date of February 20, 2001, and any use made by Applicant of the BAMA and Elephant Design mark shown in the Application, Opposer and/or its predecessors adopted, used and continue to use trademarks consisting of stylized elephant and elephant head designs ("Opposer's Elephant Design Marks"), in connection with Opposer's baseball game and exhibition services and a wide variety of related goods and services, including, but not limited to, clothing, jewelry, printed material and novelty items.

3. Since long prior to the Application filing date of February 20, 2001, and any use made by Applicant of the BAMA and Elephant Design mark shown in the Application, Opposer, its predecessors, and/or their licensees have promoted and advertised the sale and distribution of a wide range of goods and services bearing Opposer's Elephant Design Marks, including in connection with baseball game and exhibition services and a wide variety of goods and services, including, but not limited to, clothing, jewelry, printed matter and novelty items, and have sold and/or distributed such goods and rendered such services in interstate commerce. As a result of said promotion and sales of its goods and services bearing Opposer's Elephant Design Marks, Opposer has built up a highly valuable goodwill in Opposer's Elephant Design Marks, which have become closely and uniquely identified and associated with Opposer.

4. Opposer owns United States federal registrations for certain of Opposer's Elephant Design Marks for goods and services in International Classes 14, 16, 25 and 41, namely U.S. Registration Nos. 1, 951,990 and 1,924,370 ("Opposer's U.S. Registrations").

5. On February 20, 2001, The Board of Trustees of the University of Alabama ("Applicant") filed a use-based application to register the BAMA and Elephant Design Mark consisting of a stylized elephant head design and the word BAMA covered in the Application for a variety of goods in International Classes 6, 11, 14, 16, 20, 21, 25, and 28 ("Applicant's BAMA and Elephant Design Mark").

6. The goods covered by International Classes 6, 11, 14, 16, 20, 21, 25 and 28 in the Application are identical and/or closely related to the goods offered and services rendered in connection with Opposer's Elephant Design Marks and covered by Opposer's U.S. Registrations.

7. Upon information and belief, the goods in International Classes 6, 11, 14, 16, 20, 21, 25 and 28, covered by the Application, and Opposer's goods and services offered in connection with Opposer's Elephant Design Marks are likely to be sold or rendered through the same channels of trade and ultimately to the same kinds of consumers.

8. Applicant's BAMA and Elephant Design mark so resembles Opposer's Elephant Design Marks so as to be likely, when applied to Applicant's goods in Classes 6, 11, 14, 16, 20, 21, 25 and 28, to cause confusion, to cause mistake, and to deceive the trade and public, which are likely to believe that Applicant's goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's BAMA and Elephant Design mark in Classes 6, 11, 14, 16, 20, 21, 25 and 28.

9. Opposer would be further injured by the granting of a certificate of registration to Applicant for the goods in Classes 6, 11, 14, 16, 20, 21, 25 and 28, because Applicant's BAMA and Elephant Design mark used in connection with these goods would falsely suggest a connection between Applicant and Opposer.

10. Opposer's Elephant Design Marks are distinctive and famous and were so long prior to the Application filing date of February 20, 2001, or any use made by Applicant of the BAMA and Elephant Design mark shown in the Application. Registration of Applicant's BAMA and Elephant Design mark in Classes, 6, 11, 14, 16, 20, 21, 25 and 28 will also injure Opposer by diluting the distinctive quality of Opposer's Elephant Design Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Elephant Design mark shown in the Application in Classes 6, 11, 14, 16, 20, 21, 25 and 28, and prays that the opposition be sustained and said registration be denied with respect to said classes.

Filing Fee: The Patent & Trademark Office is authorized to charge the \$2,400.00 for the filing of an opposition against eight (8) classes in the Application, and any additional fees which may be required, or to credit any overpayment to **Deposit Account 03-1952 (Reference No. 529332400334)**. A duplicate copy of this document is being provided for that purpose.

Please recognize as attorneys for Opposer in this proceeding Rosemary S. Tarlton (member of the Bar of the State of California) and the firm of Morrison & Foerster LLP, 425 Market Street, San Francisco, CA 94105-2482.

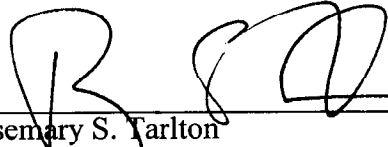
Please address all communications to Rosemary S. Tarlton at the address below.

Dated: San Francisco, California

June 11, 2004

Respectfully submitted,

MORRISON & FOERSTER LLP

By: 
Rosemary S. Tarlton

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June 14, 2004



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06-14-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Re: *Athletics Investment Group LLC, d/b/a The Oakland Athletics Baseball Company v. The Board of Trustees of the University of Alabama*
Opposition No.: To Be Assigned
Mark: BAMA and Design, Serial No. 76/212,456
Our Reference No.: 52933-24003.34

Dear Commissioner:

Enclosed for filing is a Notice of Opposition (in triplicate), and a receipt verification postcard in the above-referenced matter.

The Commissioner is hereby authorized to charge \$2,400.00 for the opposition to eight classes identified in the referenced application, and any additional fees which may be required, or to credit any overpayment, to **Deposit Account No. 03-1952 (our reference no. 529332400334)**. A duplicate copy of this letter and the Notice of Opposition is enclosed for this purpose.

Very truly yours,

Rosemary S. Tarlton